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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,673	03/21/2001	Dilip Gajendragadkar	10320-006-999	5469

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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,673

Applicant(s)

GAJENDRAGADKAR, DILIP

Examiner

Clement B Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/05/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 4-13, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-2, 4-13, do not recite any structure or functionality to suggest that a computer performs the recited claims. Thus, claims 1-2, 4-13, are rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Towers U.S Patent 4, 334, 270.

As per claims 1, 7-8, Towers discloses a method for creating a stock certificate holdings record, comprising: receiving data related to a stock certificate ("i. e, "security") (see column 233 lines 43-60) and displaying a portion ("i. e, security number" see column 233 lines 51-55) of said stock certificate holdings record to the holder (see

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column 234 lines 13-32) and parsing (i. e, sorted") said data to identify its constituent elements("i. e, security number") (Note abstract and see column 233 lines 51-63 and see column 6 lines 33-57) and creating a stock certificate holdings record for a holder identified in said data.(see column 5 lines 54-68) and said stock certificate holdings record based upon said constituent elements. (see column 233 lines 51-55)

Towers fail to explicitly teach over a computer network.

However Towers discloses means for storing and displaying information about investment securities and segregating said data files into a first group of files containing those securities in which daily pricing information is available in electronically encoded form.(Note abstract see column 234 lines 14-17 and column 233 lines 27-29).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Towers would have been able to perform transactions over a computer network in order to display security records.

As per claim 2, Towers fail to explicitly teach, wherein said receiving step comprises receiving a data file from the issuer.

However receiving a data file from the issuer or a third party would not have affected the main function of the system, because the importance factor would have been to receive accurate data, because parsing or sorting the data, would have been the next step after the data is received.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Towers to include receiving a data file from the issuer because receiving a data file from the issuer or a third party would not have affected the main function of the system, because the importance factor would have been to receive accurate data, because parsing or sorting of the data, would have been the next step after the data is received.

As per claim 3, Towers fail to explicitly teach wherein said receiving step comprises said issuer uploading said data directly to a computer system configured to maintain stock certificate holdings records.

However Towers discloses segregating said data files into a first group of files containing those securities in which daily pricing information is available in electronically

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encoded form and the computer maintains securities information in the system wide files which are updated both electronically and manually .(Note abstract see column 234 lines 14-17 and column 233 lines 27-29).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Towers when applied would have been able to upload said data directly to a computer system configured to maintain stock certificate holdings records in order for display or distribution.

As per claim 4, Towers fail to explicitly teach wherein said parsing step includes a computer program comparing said data to an existing stock certificate holdings record to identify an error in said data.

However comparing data to an stock holdings record to identify an error in said data is old an well known in the art because records can be compared for different types of errors for example, for example, duplicate records, or unmatched records.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Towers to include parsing step includes a computer program comparing said data to an existing stock certificate holdings record to identify an error in said data because records can be compared for different types of errors for example, for example, duplicate records, or unmatched records

As per claim 5, Towers fail to explicitly teach wherein said error includes the existing stock certificate holdings record having a stock certificate number included in said data.(see column 233 lines 43-50).

As per claim 6, Towers fail to explicitly teach , wherein said error includes the existing stock certificate holdings record having a first identifier of an issuer of a stock certificate and said data having a second identifier of the issuer.

However it is common during the parsing or comparing of data for errors to occur for example, such as duplicate records, or unmatched records among others.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Towers to include wherein said error includes the existing stock certificate holdings record having a first identifier of an issuer

of a stock certificate and said data having a second identifier of the issuer because it is common during the parsing or comparing of data for errors to occur for example, such as duplicate records, or unmatched records among others.

As per claim 9, Towers discloses wherein said data describes a plurality of holders.(i. e, "users" see column 232 lines 55-60).

Towers fail to explicitly such that said creating step and said displaying step are repeated for each of said plurality of holders.

However it would have been obvious that creating step and said displaying step are would have been repeated for each of said plurality of holders because each holder would have represented a new account.

Therefore it would have been obvious to one of ordinary skill in the art that the teachings of Towers when applied would have been able to repeat creating and displaying step because it would have been obvious that creating step and said displaying step would have been repeated for each of said plurality of holders because each holder would have represented a new account.

As per claim 10, Towers fail to teach wherein said computer network is the Internet.

However there are private and public networks and the type of network used would not have prevented the system from performing its main functions of creating and displaying securities records because a private network can have access to the same data as the internet.

Therefore it would have been obvious to one of ordinary skill in the art that the teachings of Tower modified to include a computer network is the Internet would not have been more efficient than a private network because the type of network used would not have prevented the system from performing its main functions of creating and displaying securities records because a private network can have access to the same data as the internet.

As per claims 11-13, Towers fail to explicitly wherein said data is also related to a merger of two or more corporations, and wherein said data is also related to an

acquisition of a first corporation by a second corporation or wherein said data is also related to an initial public offering by a corporation.

However the relationship of the data does not prevent the system from performing its main functions of creating securities records for its users and displaying those records.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Tower to include wherein said data is also related to a merger of two or more corporations, and wherein said data is also related to an acquisition of a first corporation by a second corporation or wherein said data is also related to an initial public offering by a corporation because the relationship of the data does not prevent the system from performing its main functions of creating securities records for its users and displaying those records.

As per claims 14, 20-22, Towers discloses a computer program product for use in conjunction with a computer system, the computer program product comprising a computer readable storage medium and a computer program mechanism embedded therein, the computer program mechanism comprising (see column 233 lines 43-60) and instructions for receiving data related to a stock certificate ("i. e, security") (see column 233 lines 43-60) and instructions for parsing ("i. e, sorted") said data to identify its constituent elements ("i. e, security number " note abstract and see column 233 lines 51-63 and see column 6 lines 33-57) instructions for creating a stock certificate holdings record for a holder identified in said data (see column 5 lines 54-68) said stock certificate holdings record based upon said constituent elements (see column 233 lines 51-55) and instructions for displaying a portion of said stock certificate holdings record to the holder(see column 233 lines 51-55)

Towers fail to explicitly teach over a computer network.

However Towers discloses means for storing and displaying information about investment securities and segregating said data files into a first group of files containing those securities in which daily pricing information is available in electronically encoded form.(Note abstract see column 234 lines 14-17 and column 233 lines 27-29).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Towers would have been able to perform transactions over a computer network in order to display security records.

As per claim 15, Towers fail to explicitly teach, wherein said data is a data file received from an issuer of the stock certificate.

However receiving a data file from the issuer or a third party would not have affected the main function of the system, because the importance factor would have been to receive accurate data, because parsing or sorting the data, would have been the next step after the data is received.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Towers to include receiving a data file from the issuer because receiving a data file from the issuer or a third party would not have affected the main function of the system, because the importance factor would have been to receive accurate data, because parsing or sorting of the data, would have been the next step after the data is received.

As per claim 16, Towers fail to explicitly teach wherein said computer program mechanism further comprises instructions for receiving said data when uploaded directly to the computer system, said computer system configured to maintain stock certificate holdings records.

However Towers discloses segregating said data files into a first group of files containing those securities in which daily pricing information is available in electronically encoded form and the computer maintains securities information in the system wide files which are updated both electronically and manually (Note abstract see column 234 lines 14-17 and column 233 lines 27-29).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Towers when applied would have been able to upload said data directly to a computer system configured to maintain stock certificate holdings records in order for display or distribution.

As per claim 17, Towers fail to explicitly teach wherein said computer program mechanism further comprises instructions for comparing said data to an existing stock certificate holdings record to identify an error in said data.

However comparing data to an stock holdings record to identify an error in said data is old an well known in the art because records can be compared for different types of errors for example, for example, duplicate records, or unmatched records.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Towers to include parsing step includes a computer program comparing said data to an existing stock certificate holdings record to identify an error in said data because records can be compared for different types of errors for example, for example, duplicate records, or unmatched records

As per claim 18, Towers discloses wherein said error includes the existing stock certificate holdings record having a stock certificate number included in said data. (see column 233 lines 43-50).

As per claim 19, Towers fail to explicitly teach wherein said error includes the existing stock certificate holdings record having a first identifier of an issuer of a stock certificate and said data having a second identifier of the issuer.

However it is common during the parsing or comparing of data for errors to occur for example, such as duplicate records, or unmatched records among others.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Towers to include wherein said error includes the existing stock certificate holdings record having a first identifier of an issuer of a stock certificate and said data having a second identifier of the issuer because it is common during the parsing or comparing of data for errors to occur for example, such as duplicate records, or unmatched records among others.

As per claim 23, Towers fail to teach wherein said computer network is the Internet.

However there are private and public networks and the type of network used would not have prevented the system from performing its main functions of creating and displaying

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securities records because a private network can have access to the same data as the internet.

Therefore it would have been obvious to one of ordinary skill in the art that the teachings of Tower modified to include a computer network is the Internet would not have been more efficient than a private network because the type of network used would not have prevented the system from performing its main functions of creating and displaying securities records because a private network can have access to the same data as the internet.

As per claims 24-26, Towers fail to explicitly wherein said data is also related to a merger of two or more corporations, and wherein said data is also related to an acquisition of a first corporation by a second corporation or wherein said data is also related to an initial public offering by a corporation.

However the relationship of the data does not prevent the system from performing its main functions of creating securities records for its users and displaying those records. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Tower to include wherein said data is also related to a merger of two or more corporations, and wherein said data is also, related to an acquisition of a first corporation by a second corporation or wherein said data is also related to an initial public offering by a corporation because the relationship of the data does not prevent the system from performing its main functions of creating securities records for its users and displaying those records.

Conclusion

4. The prior art of record and not relied upon is considered pertinent to Applicants disclosure.

Shavit Eyal (US Patent 4, 799, 156) teaches interactive market management systems.

Borgato Sergio (US Patent 5,950, 178) teaches data processing system and method for facilitating transaction in diamonds.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

November 27, 2004


FRANTZY POINVIL
PRIMARY EXAMINER

All 3628